

REMARKS

Reconsideration and withdrawal of the rejection and the allowance of all claims now pending in the above-identified patent application (*i.e.* Claims 35-38, 43, 45-48, 60-63 and 65-82) are respectfully requested in view of the foregoing amendments and the following remarks.

At the outset, it should be recalled that the present invention relates to a computer software program for a document management system, which tracks and allows for searching of various documents from the creation to destruction of the document, and is particularly useful in large enterprise organization, but is nevertheless well-suited for medium-sized, and smaller, organizations.

As now most broadly claimed, the document management extension system of the present invention includes an information store having a database and a messaging system for storing documents managed by the document collection and management software, with documents capable of being stored in only one or both of the database and the messaging system and, preferably, with the database for the stored documents further comprising a profile for the documents stored therein. Documents are not to be stored in a conventional filing system, as taught by the prior art, including the art newly cited and applied by the Examiner. The document management extension system also includes document indexing of the database or messaging system of the stored documents, along with processing of the documents, stored in either the database or messaging system of the information store.

While not essential, the document management extension system of the presently claimed invention is preferably used in combination with Microsoft Exchange, by which the document management extension system merges the functionality of index databases, file repositories and messaging system using Microsoft Exchange, while leveraging the tight integration of Microsoft Exchange and an NT server for security and redundancy management. This would include a user interface, which is accessed through dialogs in specific software application programs or through a "find" application.

As will be explained in greater detail hereinafter, nowhere in the prior art is such an efficient and useful document management extension software program for management of documents in organizations of all sizes, which stores documents solely in an information store (*i.e.*, only in the database and/or messaging system), and in which the content of the document is preferably stored in the same database as the document's profile, either disclosed or suggested.

By the present amendments, Applicants have amended independent Claim 35 (and pending Claims 36-38, 43, 45-48 and 60-63 via dependency) to now expressly recite that the content of the document is "only" stored in the database and/or the messaging system. The amendment now being entered into Claim 35 is intended to exclude, even partially, storage of the content of the document on the file system.

Case law support for "closing" the language of one claim element, but not otherwise closing the language of the entire claim, is found in *Mannessman Demag Corp. v. Engineered Metal Products Co., Inc.*, 793 F.2d 1279, 230 USPQ 45, 46 (Fed. Cir. 1986);

Berenter v. Quigg, 737 F.Supp. 5, 14 USPQ2d 1175-1176 (D.D.C. 1988) (citing to the Federal Circuit in *Mannessman*, the district court reversed the Board of Appeals' affirmation of a final rejection and entered summary judgment against the PTO finding that the patent applicant was allowed to "close" the second step of a two-step method claim without closing the entire method claim to the addition of further steps, not inconsistent with closure of the second recited method step). Consequently, Applicants may properly limit independent Claim 35 (and those claims depending therefrom) to exclude storage of the content of document on the file system, while not otherwise "closing" the entirety of the claim to additional elements not inconsistent with the content of documents being stored exclusively on either the database and/or the messaging system of the information store.

Applicants have also added new Claim 65 (which depends from independent Claim 35) to recite the preferred embodiment that the database for the stored documents also includes the profile of the stored documents. This contrasts with the prior art, including that newly cited by the Examiner in the third Office Action, which teaches that the content of the document are to be stored, at least partially, on the file system.

Applicants have also cancelled dependent Claims 39-42, 44, 49-59 and 64, the subject matter of which the Examiner indicated to be allowable over the prior art in both the second ("final") Office Action, dated January 27, 2005; and the third Office Action, dated August 22, 2005, and have added new Claims 66-82 for the purpose of independently presenting such allowable subject matter as pending prior to Applicants' Response filed on May 18, 2005. In view of the Examiner's indicated allowability of dependent

Claims 39-42, 44, 49-59 and 64, Applicants respectfully submit that new Claims 66-82 are in condition for allowance at this time, and should therefore be allowed. (Dependent Claim 41, though not indicated as being allowable by the Examiner and, in fact, rejected as being obvious in the Office Actions dated January 27, 2005; and August 22, 2005, was directly dependent upon allowable Claim 40, rather than a "rejected" claim, and it is therefore respectfully submitted that Claim 41 should have been indicated as reciting "allowable" subject matter, but properly "objected to" as being indirectly dependent upon rejected base Claim 35. Applicants have therefore treated dependent Claim 41 as having recited allowable subject matter, which would appear to be consistent with the Examiner's intent and indication that Claims 39 and 40, in fact, recited subject matter allowable over the prior art.)

The instant patent application now has pending seven (8) independent claims (*i.e.*, Claims 35, 66, 70, 71, 72, 80, 81 and 82) and, consequently, the additional claims fee of \$500.00 (small entity), for the pendency of five independent claims beyond the three independent claims covered by the previously-paid filed fees, is enclosed. Further, the application now has a total of 31 pending claims, a net increase of one (1) pending claim over the total number of claims pending prior to the instant claim amendments, and for which the additional claims fee of \$25.00 (small entity) is due. Accordingly, Applicants includes a check in the amount of \$525.00 (small entity) to cover the pendency of the claims, as herein amended.

Turning now, in detail, to an analysis of the Examiner's prior art rejections, in the

third Office Action the Examiner has rejected independent Claim 35 as being anticipated, pursuant to 35 U.S.C. §102(e), by newly-cited Watkins *et al.*, U.S. Patent Application Publication No. US 2001/0054042 A1, published December 20, 2001, and having a non-provisional filing date of May 16, 1997, on the contention that Watkins *et al.* teaches a computing system for information management that includes a method and associated system having an information store comprising a database and a messaging system (citing to Watkins *et al.*, FIG. 1, elements 1, 2, 6) for storing documents managed by a document collection and management software program, along with means for storing documents in one or both of the database and messaging system (Watkins *et al.*, Paragraph Nos. 0028 - 0033). According to the Examiner, Watkins *et al.* further teaches document indexing of the database or messaging system of the stored documents and processing of the stored documents stored in either of the database or messaging system, as recited by Applicants in Claim 35, thereby anticipating Applicants' broadest claim.

In reply to the Examiner's anticipation rejection applying the Watkins *et al.* patent application publication, and as an initial matter, Applicants wish to point out their application is a "Pre PG-PUB" application, as defined by the *Manual of Patent Examining Procedure*, §706.02(a), in that their application was filed prior to November 29, 2000, and was not voluntarily published in the United States. As such, only the "prior" version of 35 U.S.C. §102(e) would be applicable against the instant patent application, which would exclude citation of published United States patent applications, regardless of their U.S. filing dates. Applicants would therefore respectfully object to the citation of any published U.S. patent application in the prosecution of their application, *absent a show-*

ing that the published U.S. application ultimately issued as a patent and had substantially the same disclosure (in which case, the issued United States patent should be applied.)

Watson *et al.*, applied by the Examiner in the anticipation rejection of the third Office Action, ultimately issued on September 24, 2002, as U.S. Patent No. 6,457,017, and would appear to have substantially the same disclosure, but not the same claims. Applicants, therefore, do not object to the application of the Watson *et al.* published application by the Examiner, at this time, *but do wish to reserve the right to object to its application if it later appears as though subject matter relied upon by the Examiner in the published application is absent from the issued patent.*

In reply to the merits of the Examiner's application of Watkins *et al.*, this citation discloses a computing system for information management, which is submitted to be little different from that taught by Porter *et al.*, U.S. Patent No. 5,845,067, which was applied against Claim 35 in the "final" Office Action, dated January 27, 2005, in that Watkins *et al.* is but an example of where the "objects," or information about the stored documents (*i.e.*, profile or index for the stored documents), are stored in a database, while the documents themselves are stored, at least partially, in the file system. This feature of Watkins *et al.* is evident from FIG. 7 of both the published application and issued patent, which depicts a document management subsystem which stores its data partially in an ODBC, which is a database and partially on the file system. This understanding of what is taught by Watkins *et al.* is confirmed by the statement in Paragraph No. 0067 of the published application (*see, also*, U.S. Patent No. 6,457,017 at Col. 7, lines 40-41), which states that

"[m]anged files from the file system 4 are represented as relational database information in the ODBC database 62." (*See, also, Watkins et al.*, published application at Paragraphs Nos. 0116 - 0118 (U.S. Patent No. 6,457,017 at Col. 14, lines 29-42))

In contrast to that which is disclosed and suggested by *Watkins et al.*, Applicants' independent Claim 35 (and dependent Claims 36-38, 43, 45-48, 60-63 and 65), as now amended, recites that the stored documents are to be stored "only" in either the database and/or the messaging system, thereby excluding even partial document storage on the file system, as *Watkins et al.* teaches. In *Watkins et al.*, and as discussed in connection with *Porter et al.* in Applicants' Response (at pp. 18-19), filed May 18, 2005, and as it concerns the prior art generally, the location of the content of the documents is one of the critical elements that the system is managing. It is the system's ability "to know" where on the file system that information is located, which forms a primary part of its value and, which Applicants contend, is a significant drawback inherent in the prior art, including that of *Watkins et al.* All is fine and acceptable with the document management system taught by *Watkins et al.* and *Porter et al.*, among others, when the document management system is managing the location of the content. If, however, the content is inadvertently moved by another process (*e.g.*, server relocation), then such prior art document management systems fail. *Watkins et al.* teaches that the content of the documents may be, at least partially, stored on the file system. Consequently, the drawback inherent in the prior art, generally, is not avoided by *Watkins et al.*, even if *Watkins et al.* might teach partial storage in a database ("ODBC.")

It is precisely this weakness in Watkins *et al.*, and the overall prior art of record, that the presently claimed invention seeks to overcome by locating the object content in the same repository as the metadata (*i.e.*, the index), whether that repository be a database or a messaging system. With the present invention, the content is always managed with the index data as a logical whole and, consequently, it is not possible to disassociate the two - which is not the situation with Watkins *et al.*, which teaches at least partial document storage on the file system! Stated differently, the actual location of the content becomes irrelevant with the document management system of the presently claimed invention, inasmuch as the content location of a document is being managed, at all times, by the underlying information store (*i.e.*, either the messaging system or the database.) As a result, the data location of a document has been "virtualized," in the sense that its actual physical location (such as in a file system) becomes irrelevant.

Accordingly, withdrawal of the Examiner's 35 U.S.C. §102(e) anticipation rejection of the final Office Action, which applies Watkins *et al.* against independent Claim 35, is respectfully requested.

Separately, the Examiner has also rejected Claims 35-38, 41, 45-48 and 60-63 as being obvious, pursuant to 35 U.S.C. §103(a), over Watkins *et al.*, as applied against Claim 35, and taken in further view of Porter *et al.*, U.S. Patent No. 5,845,067, earlier made of record in the present prosecution. The Examiner's obviousness rejection, discussed at Pages 4 - 5 of the third Office Action, details how the combination of Watkins *et al.* and Porter *et al.* is applied against the dependent claims enumerated in the obvious-

ness, but does not discuss how the combined art is applied against independent Claim 35, beyond what is incorporated by reference from the 35 U.S.C. §102(e) anticipation rejection which applies *Watkins et al.*, and as detailed above. It is therefore respectfully submitted to be unclear as to whether the Examiner intended to include independent Claim 35 in the obviousness rejection or simply restrict the obviousness rejection to solely certain pending dependent claims.

Notwithstanding whether the obviousness rejection of the third Office Action is intended to include independent Claim 35, as detailed above, *Watkins et al.*, at least partially, stores documents on the file system, while the present invention stores documents solely in the database and/or messaging system. Because *Watkins et al.* stores documents on the file system, the primarily-applied citation cannot reasonably be seen as teaching or suggesting the importance of, and benefits attained by, not storing the content of documents on the file system, *e.g.*, if the document content is inadvertently moved by another process (*e.g.*, server relocation), then prior art document management systems, such as *Watkins et al.*, fail to the extent that the stored documents were placed on the file system.

As for the secondarily-applied art of *Porter et al.*, this reference discloses a method and apparatus for document management utilizing a messaging system, however, *Porter et al.*, as in the case of *Watkins et al.*, teaches that "[t]he content of a document is stored in a file system, while the profile of the document is stored in a messaging system." (*Porter et al.*, Abstract, lines 1-2) According to *Porter et al.*, this prior art provides

for a document management system for which each document is sub-divided into two parts: the content of the document and the document profile. (Porter *et al.*, Col. 1, lines 18-45) The nature of the invention disclosed by Porter *et al.* provides that the document profile information (or document index or metadata) is to be stored in a messaging system, rather than a database, but that the content will still be stored on the file system. See, Porter *et al.*, Col. 2, lines 20-21 ("The content of a document is stored in a file system, while the profile of the document is stored in a messaging system.")

Because Porter *et al.* teaches storing the content of a document on a file system, while the present invention, as now broadly recited in independent Claim 35, specifies that the content of a document is to be stored in either a database, messaging system, or both, but not on the file system, Porter *et al.*, even if combined with the teachings and suggestions of Watkins *et al.*, the latter of which teaching that documents may be, at least partially, stored on the file system, cannot reasonably yield that which is now being claimed by Applicants in previously presented pending Claims 35-38, 43, 45-48 and 60-63 (and newly-entered dependent Claim 65), nor render such claims as being obvious.

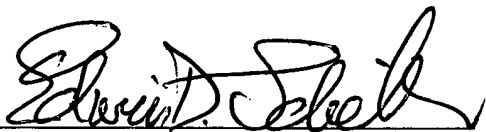
Accordingly, withdrawal of the Examiner's 35 U.S.C. §103(a) obviousness rejection, which applies Watkins *et al.* taken in view of Porter *et al.*, it is respectfully submitted, should now be withdrawn.

In view of the foregoing, it is respectfully contended that all claims now pending in the above-identified patent application (*i.e.*, Claims 35-38, 43, 45-48, 60-63 and 65-82) recite a novel and efficient document management extension software program, which

preferably provides for storage of the content of a document in solely the database and/or messaging system of an information store, but not on the file system, which is patentably distinguishable over the prior art. Accordingly, withdrawal of the outstanding rejections and the allowance of all claims now pending are respectfully requested and earnestly solicited.

Respectfully submitted,

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Enc.: Check for \$525.00 (Additional Claims Fees)

The Commissioner for Patents is hereby authorized to charge the Deposit Account of Applicants' Attorney, Account No. 19-0450, for any additional fees which may be due in connection with the prosecution of the present application, but which have not otherwise been provided for.